

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC W. EPSTEIN

Appeal No. 2004-0089
Application No. 09/949,327

ON BRIEF

Before GARRIS, WARREN and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 4, which are all the claims pending in this application.

THE INVENTION

The invention relates to a combination of a greeting card and an envelope. The greeting card contains at least two areas of different size, a larger size for displaying a message and a smaller size for displaying a distinctive design. The envelope has an opening which corresponds to the area of distinctive design. The claimed subject matter is

adequately described in the following illustrative claim.

THE CLAIM

Claim 1 is illustrative of appellant's invention and is reproduced below:

1. In combination greeting card and envelope therefor, into which said card is selectively positioned, the improvement comprising: said card having at least one surface having a first area for displaying a message, and a second relatively smaller area with a distinctive design positioned upon said second area; said envelope having at least one wall having an opening corresponding in location and size to that of said second area when said card is positioned within said envelope.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Lohnes	2,824,394	Feb. 25, 1958
Luftig	3,986,662	Oct. 19, 1976
Conn	4,245,775	Jan. 20, 1981

THE REJECTIONS

Claims 1 through 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Luftig in view of Lohnes and further in view of Conn.

OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the examiner for the reasons stated in the Answer and the reasons herein that the rejection of the claims is well founded. Accordingly, we affirm both rejections.

As an initial matter, it is the appellant's position that, "all the claims stand or fall together." See Brief, page 2. Accordingly, we select claim 1 as representative of the claimed subject matter and limit our consideration thereto. See 37 CFR1.192(c)(7)(2003).

The Rejection under Section 103

The examiner proposes two alternative positions in the rejection of record. In the first position, the only distinction between the primary reference to Luftig is in the term "greeting." See Answer, page 4. In an alternative position, the examiner considers it obvious to the person having ordinary skill in the art to substitute a greeting card in place of the accordion style letter of Luftig. Id. We sustain both positions.

Luftig is directed to an apparatus directed to a combination of a latter and an envelope. See column 1, lines 4-8. We find that the combination contains addressee information and a control number affixed to a letter. See column 1, lines 49-52. We find that the envelope and letter combination are so constructed that an attention getting design border is contiguous to the control number enclosed within the envelope. See column 1, lines 55-61. We find that the envelope includes first and second windows. See column 1, line 67 to column 2, line 1. We find a letter is provided with one area for addressee information and a second area containing at least one number and a border area proximate to the number. See column 2, lines 1-7. Two windows are present in the letter as exemplified by numerals 28 for the first window and 30 for the second window. The

letter having the first and second areas are so arranged as be visible through the first and second window openings respectively. See column 6, lines 37-41, and column 7, lines 31-38. It is evident that the second opening may be smaller than the first opening. See Figures 1 and 3. Luftig differs only from the claimed subject matter as being directed to a business card as opposed to a greeting card.

As to the first theory of rejection that the only distinction between Luftig and the claimed subject matter lies in the ultimate intended use of the card as a “greeting” card, what is required to establish is “the existence of differences between the appealed claims and the prior art sufficient to establish patentability.” See In re Gulack, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983). As stated therein “the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Id. Stated otherwise whether the term “greeting” used in the preamble to the claim creates a new and unobvious functional relationship between the printed matter and the substrate.

On the record before us, the printed subject matter utilized by Luftig displays a message in the same manner as in the card of the claimed subject matter. Similarly, the smaller area of Luftig contains a distinctive design, i.e., a number or sequence of numbers surrounded by a decorative border constitutes a distinctive design. Whether the distinctive design is something other than a number is irrelevant to the critical question before us, as regardless of the specific distinctive design before us, the functional relationship between

the printed matter and the substrate remains the same, providing a distinctive design or visual pattern associated with the letter. These critical features of the invention are disclosed by Luftig to the same extent as that required by the claimed subject matter. Accordingly, we sustain the rejection of the examiner under the first theory of rejection.

As for the second theory of rejection relying on the Lohnes reference for its disclosure of an accordion folded greeting card, we note that a substantial portion of greeting cards such as end of calendar year holiday greeting cards is customarily mailed by businesses to their customers. We see no reason why a business would not use the same customer base in the same manner as Luftig in issuing holiday greeting cards to their customers, either identifying them by number or other distinctive designs in the manner disclosed by Luftig and as required by the claimed subject matter.

Based upon the above evidentiary findings, we conclude that it would have been obvious to one of ordinary skill in the art to have utilized the folding accordion greeting card of Lohnes to replace the message in the card of Luftig. Accordingly, we affirm the rejections over Luftig in view of Lohnes and further in view of Conn.

A discussion of the Conn reference is not needed in reaching our decision.

DECISION

The rejection of claims 1 through 4 under 35 U.S.C. §103(a) as being unpatentable over Luftig in view of Lohnes and further in view of Conn is affirmed.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

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